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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,681	01/31/2000	JOACHIM BLUM	PM266043	6649

909 7590 04/30/2003

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EXAMINER

MAYEKAR, KISHOR

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 04/30/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/463,681

Applicant(s)

J. Blum et al.

Examiner

Kishor Mayekar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 24, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. Applicant's arguments with respect to claims 1-11 and new claims 12-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-12 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 90/01051 in view of SOLTWEDEL et al. (5,624,978). WO '051's invention is directed to a water-based coating composition for the temporary protection of painted surfaces of new vehicles during transit from manufacturer to automotive dealer. WO '051 discloses that the coating composition forms a firm but removable film for the protection of underlying permanent paint layers (see Example 1, lines 6-9)

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and is optionally clear (page 3, line 22) or contains pigments to provide distinctive color and/or opacity (page 13, lines 11-12). The difference between WO '051 and the above claims is the recited steps of applying and electrophoretically depositing. SOLTWEDEL, a reference cited in the previous Office action, discloses the use of an aqueous coating composition in the automotive industries which renders a metallic substrate capable of severe drawing without sacrificing corrosion protection or electrocoatability (emphasis added) and the steps of applying the aqueous coating composition on the metal substrate utilizing known coil coating process and by any other known coating techniques to form a basecoat, and stoving the basecoat (col. 11, lines 11-18), wherein the basecoat has conductive properties imparted by conductive pigments in the coating composition (col. 10, lines 40-48). SOLTWEDEL also discloses that the basecoated substrate can then be conventionally coated or electrocoated with primer coatings and then may be coated with decorative topcoats (see abstract; col. 2, lines 54-59; and Examples 1 and 2). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified WO '051's teachings as suggested by

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SOLTWEDEL because the selection of any of known equivalent vehicles' exterior finish would be within the level of ordinary skill in the art.

As to the subject matter of claims 4 and 11, SOLTWEDEL discloses that the basecoat is on both sides of the metal coil substrate (col. 9, lines 52-57).

As to the subject matter of claim 5, SOLTWEDEL that the basecoated substrate is formable and may be weldable (col. 11, lines 30-31).

As to the subject matter of claim 6, SOLTWEDEL discloses the spot welding of the basecoated steel panels (col. 11, lines 64-66).

As to the subject matter of claim 8, SOLTWEDEL discloses that the aqueous composition is useful to provide pretreatment coatings on metal substrates used in the automotive (col. 2, lines 47-50).

As to the subject matters of claims 9-10 because the claims are drafted in "product-by-process" format, how the claimed product differs from the product disclosed in the applied reference is not apparent. It is well settled that the determination of the patentability of "a product-by-process" claim is based on the product itself, and the product is unpatentable if it appears to be the same as, or

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slightly different from the prior art products which were prepared in a different manner, *In re Thorpe* 227 USPQ 964.

As to the subject matter of claim 14, WO '051 discloses in page 9, lines 33-36 that the coating thickness can be varied. As such, the selection of coating thickness would have been within the level of ordinary skill in the art.

4. Claims 1-11 and 13, 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02300281A in view of SOLTWEDEL '978. JP '281's invention is directed to a method for the temporary protecting of the coated surfaces of new finished cars by applying a removable pressure sensitive adhesive plastic film and/or wrapping with heat shrinkable plastic film and heat treating (see the english abstract). The difference between JP '281 and the above claims is the recited steps of applying and electrophoretically depositing. SOLTWEDEL, a reference cited in the previous Office action, discloses the use of an aqueous coating composition in the automotive industries which renders a metallic substrate capable of severe drawing without sacrificing corrosion protection or electrocoatability (emphasis added) and

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the steps of applying the aqueous coating composition on the metal substrate utilizing known coil coating process and by any other known coating techniques to form a basecoat, and stoving the basecoat (col. 11, lines 11-18), wherein the basecoat has conductive properties imparted by conductive pigments in the coating composition (col. 10, lines 40-48). SOLTWEDEL also discloses that the basecoated substrate can then be conventionally coated or electrocoated with primer coatings and then may be coated with decorative topcoats (see abstract; col. 2, lines 54-59; and Examples 1 and 2). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified JP '281's teachings as suggested by SOLTWEDEL because the selection of any of known equivalent vehicles' exterior finish would be within the level of ordinary skill in the art.

As to the subject matter of claims 4 and 11, SOLTWEDEL discloses that the basecoat is on both sides of the metal coil substrate (col. 9, lines 52-57).

As to the subject matter of claim 5, SOLTWEDEL that the basecoated substrate is formable and may be weldable (col. 11, lines 30-31).

As to the subject matter of claim 6, SOLTWEDEL discloses the spot welding

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of the basecoated steel panels (col. 11, lines 64-66).

As to the subject matter of claim 8, SOLTWEDEL discloses that the aqueous composition is useful to provide pretreatment coatings on metal substrates used in the automotive (col. 2, lines 47-50).

As to the subject matters of claims 9-10 because the claims are drafted in "product-by-process" format, how the claimed product differs from the product disclosed in the applied reference is not apparent. It is well settled that the determination of the patentability of "a product-by-process" claim is based on the product itself, and the product is unpatentable if it appears to be the same as, or slightly different from the prior art products which were prepared in a different manner, *In re Thorpe* 227 USPQ 964.

As to the subject matter of claim 14, the selection of coating thickness would have been within the level of ordinary skill in the art.

5. Claims 1-12, 14, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over SADLER et al. (4,626,559) in view of SOLTWEDEL '978. SADLER's

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invention is directed to an aqueous dispersion non-permanent ornamental paint mixture for the decoration of vehicles' exterior finish in the form of slogans and statements written on the vehicles to indicate the support from athletic sponsors and boosters to the chosen team, wherein the paint mixture comprising an aqueous pigment dispersion to provide the color (see abstract) and an acrylic emulsion copolymer to inhibit the removal of the pigment after drying by wiping (col. 2, lines 15-23). The difference between SADLER and the above claims is the recited steps of applying and electrophoretically depositing. SOLTWEDEL, a reference cited in the previous Office action, discloses the use of an aqueous coating composition in the automotive industries which renders a metallic substrate capable of severe drawing without sacrificing corrosion protection or electrocoatability (emphasis added) and the steps of applying the aqueous coating composition on the metal substrate utilizing known coil coating process and by any other known coating techniques to form a basecoat, and stoving the basecoat (col. 11, lines 11-18), wherein the basecoat has conductive properties imparted by conductive pigments in the coating composition (col. 10, lines 40-48). SOLTWEDEL also discloses that the basecoated substrate can then be

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conventionally coated or electrocoated with primer coatings and then may be coated with decorative topcoats (see abstract; col. 2, lines 54-59; and Examples 1 and 2). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified SADLER's teachings as suggested by SOLTWEDEL because the selection of any of known equivalent vehicles' exterior finish would be within the level of ordinary skill in the art.

As to the subject matter of claims 4 and 11, SOLTWEDEL discloses that the basecoat is on both sides of the metal coil substrate (col. 9, lines 52-57).

As to the subject matter of claim 5, SOLTWEDEL that the basecoated substrate is formable and may be weldable (col. 11, lines 30-31).

As to the subject matter of claim 6, SOLTWEDEL discloses the spot welding of the basecoated steel panels (col. 11, lines 64-66).

As to the subject matter of claim 8, SOLTWEDEL discloses that the aqueous composition is useful to provide pretreatment coatings on metal substrates used in the automotive (col. 2, lines 47-50).

As to the subject matters of claims 9-10 because the claims are drafted in

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"product-by-process" format, how the claimed product differs from the product disclosed in the applied reference is not apparent. It is well settled that the determination of the patentability of "a product-by-process" claim is based on the product itself, and the product is unpatentable if it appears to be the same as, or slightly different from the prior art products which were prepared in a different manner, *In re Thorpe* 227 USPQ 964.

As to the subject matter of claim 14, the selection of coating thickness would have been within the level of ordinary skill in the art.

Response to Arguments

6. Applicant's arguments filed August 19, 2002 have been fully considered but they are not persuasive in view of the new ground rejection as set forth in the paragraph above.

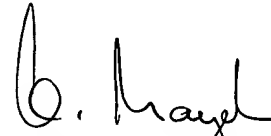
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (703)

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308-0477. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on (703) 308-3322. The fax phone number for this Group is (703) 872-9310 (non-after finals) or 872-9311 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Kishor Mayekar
Primary Examiner
Group 1700

KM
April 23, 2003